UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,885	01/09/2001	Muhammad Chishti	018563-002400US	6714

46718 7590 04/19/2007

TOWNSEND AND TOWNSEND AND CREW, LLP (018563)
TWO EMBARCADERO CENTER, EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER	
NAJARIAN, LENA	
ART UNIT	**PAPER NUMBER**
3626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

APR 19 2007

GROUP 3600

Application Number: 09/756,885
Filing Date: January 09, 2001
Appellant(s): CHISHTI ET AL.

Michael T. Rosato
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/3/07 appealing from the Office action mailed 3/3/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,014,629	DEBRUIN-ASHTON	1-2000
US 2002/0152096 A1	FALCHUK et al.	10-2002
5,225,976	TAWIL	7-1993

6,385,620	KURZIUS et al.	5-2002
US 2002/0032583 A1	JOAO	3-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Falchuk et al. (US 2002/0152096 A1), and further in view of Tawil (5,225,976).

(A) Referring to claim 1, DeBruin-Ashton discloses a method for referring patients to practitioners, said method comprising (col. 1, lines 36-39 of DeBruin-Ashton; the Examiner interprets "directing" to be a form of "referring," "customers" to be a form of "patients," and "physicians" to be a form of "practitioners"):

identifying individual patients who wish to receive the procedure (col. 6, lines 1-3 of DeBruin-Ashton);

accessing an electronic database (Fig. 1 of DeBruin-Ashton)

and

providing to the identified individual patients a list of certified practitioners (col. 6, lines 56-62 of DeBruin-Ashton), selected from the electronic database, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list (col. 12, lines 47-54 of DeBruin-Ashton; the Examiner interprets using "selection algorithms" and "applying weighting factors to the selection process" to be a form of placing practitioners with a certain amount of experience "preferentially on a list").

DeBruin-Ashton does not disclose certifying a group of practitioners to perform a medical procedure.

Falchuk discloses certifying a group of practitioners to perform a medical procedure (para. 21 and para. 30 of Falchuk; the Examiner interprets "accreditation" to be a form of "certifying").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Falchuk within DeBruin-Ashton. The motivation for doing so would have been to educate medical professionals for effective delivery of health care services (para. 8, lines 6-9 of Falchuk).

DeBruin-Ashton teaches selection algorithms for certain physicians to be represented in higher proportion (col. 12, lines 47-54 of DeBruin-Ashton). However, DeBruin-Ashton and Falchuk do not disclose the number of procedures performed by each of the group of certified practitioners.

Tawil discloses tracking the number of times the provider has performed the procedure (col. 3, lines 3-21 of Tawil).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Tawil within DeBruin-Ashton and Falchuk. The motivation for doing so would have been to include background information on providers available for review by the patient to assist the patient's decision-making process (col. 4, lines 57-59 of Tawil).

(B) Referring to claims 2-4, DeBruin-Ashton does not disclose wherein certifying the practitioners comprises training practitioners, wherein certifying the practitioners comprises testing the practitioners, and wherein certifying comprises requiring that the practitioners have performed at least one procedure.

Falchuk discloses wherein certifying the practitioners comprises training practitioners (para. 21 of Falchuk), wherein certifying the practitioners comprises testing the practitioners (para. 30 of Falchuk), and wherein certifying comprises requiring that the practitioners have performed at least one procedure (para. 30, lines 17-21 of Falchuk; the Examiner interprets "credits accumulated" to be a form of "performed at least one procedure").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Falchuk within DeBruin-Ashton. The motivation for doing so would have been to ensure standards and the effective delivery of health care services (para. 8, lines 6-9 of Falchuk).

(C) Referring to claim 5, DeBruin-Ashton discloses removing practitioners from the certified group (col. 2, lines 42-44 of DeBruin-Ashton; the Examiner interprets

"updated...to reflect...the physicians that left the service" to be a form of "removing practitioners").

(D) Referring to claim 12, DeBruin-Ashton discloses wherein identifying individual patients comprises collecting names and contact information from individual patients (col. 5, lines 65-67 of DeBruin-Ashton; the Examiner interprets "address" to be a form of "contact information" and "customer" to be a form of "patient").

(E) Referring to claim 13, DeBruin-Ashton discloses wherein at least some of the individual patients contact a coordinator in response to solicitations (col. 4, lines 31-47 of DeBruin-Ashton; the Examiner interprets "advertising materials" to be a form of "solicitations").

Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Falchuk et al. (US 2002/0152096 A1) as applied to claim 1 above, in view of Tawil (5,225,976), and further in view of Kurzius et al. (6,385,620 B1).

(A) Referring to claim 6, DeBruin-Ashton discloses wherein practitioners are preferentially placed on lists (col. 12, lines 47-54 of DeBruin-Ashton; the Examiner interprets using "selection algorithms" and "applying weighting factors to the selection process" to be a form of "preferentially placed on lists").

DeBruin-Ashton and Falchuk do not disclose wherein the practitioners are placed into tiers based on the number of procedures performed.

Tawil discloses tracking the number of times the procedure has been performed (col. 3, lines 11-21 of Tawil).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Tawil within DeBruin-Ashton and Falchuk. The motivation for doing so would have been to include background information on providers available for review by the patient to assist the patient's decision making process (col. 4, lines 57-59 of Tawil).

Kurzius discloses placing candidates into tiers based on experience and proficiency level (col. 17, lines 48-52 of Kurzius).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Kurzius within DeBruin-Ashton, Falchuk, and Tawil. The motivation for doing so would have been to have a ranking system that would save patients time associated with the review of practitioner profiles (col. 15, lines 45-50 of Kurzius).

(B) Referring to claim 7, DeBruin-Ashton discloses wherein the individual practitioners are randomly ordered within a tier (col. 8, lines 36-42 of DeBruin-Ashton; the Examiner interprets "random selection process" to be a form of "randomly ordered within a tier").

(C) Referring to claims 8-10, DeBruin-Ashton and Falchuk do not disclose wherein each tier is defined by a threshold number of procedures performed over a selected period of time, wherein each tier is defined by the aggregate number of procedures performed, and wherein the practitioners are assigned to at least three tiers.

Tawil discloses tracking the number of times the practitioner has performed the procedure within a given amount of time (col. 3, lines 11-13 of Tawil).

Kurzius discloses wherein candidates are assigned to at least three tiers (col. 17, lines 48-52 of Kurzius; the Examiner interprets "beginner, intermediate, full-understanding, or expert" to be a form of "tiers").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Tawil and Kurzius within DeBruin-Ashton and Falchuk. The motivation for doing so would have been to provide information for review by the patient to assist the patient's decision making process (col. 4, lines 57-59 of Tawil) and to sort the practitioners by proficiency level (col. 17, lines 48-52 of Kurzius).
(D) Referring to claim 11, DeBruin-Ashton and Falchuk do not disclose wherein the practitioners are assigned to an initial tier when they become certified, to an intermediate tier when they treat a first threshold number of patients over a preselected time period, and to a higher tier when they treat a second threshold number of patients over the preselected time period.

Tawil discloses tracking the number of times the practitioner has performed the procedure within a given amount of time (col. 3, lines 11-13 of Tawil).

Kurzius discloses placing candidates into tiers based on experience and proficiency level (col. 17, lines 48-52 of Kurzius).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Tawil and Kurzius within DeBruin-Ashton and Falchuk. The motivation for doing so would have been to provide information for review

by the patient to assist the patient's decision making process (col. 4, lines 57-59 of Tawil) and to sort the practitioners by proficiency level (col. 17, lines 48-52 of Kurzius).

Claims 14, 16-19, 21-22, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Joao (US 2002/0032583 A1). (A) Referring to claim 14, DeBruin-Ashton discloses a method for referring patients to practitioners, said method comprising (col. 1, lines 36-39 of DeBruin-Ashton; the Examiner interprets "directing" to be a form of "referring," "customers" to be a form of "patients," and "physicians" to be a form of "practitioners"):

informing a potential patient population of the availability of the procedure (col. 4, lines 60-63 and col. 12, lines 19-22 of DeBruin-Ashton; the Examiner interprets "advertising" to be a form of "informing");

identifying individual patients who wish to receive the procedure (col. 6, lines 1-3 of DeBruin-Ashton);

accessing an electronic database having information (see Fig. 1 and abstract of DeBruin-Ashton); and

providing to the identified individual patients referral lists of certified practitioners, selected from the electronic database, wherein individual practitioners are preferentially placed on the referral lists based on one or more performance criteria (col. 3, line 49 – col. 4, line 14 of DeBruin-Ashton; the Examiner interprets "directory" to be a form of "referral lists" and "having specialties corresponding to a particular customer's needs" to be a form of "performance criteria").

DeBruin-Ashton does not disclose wherein the practitioner is a dental practitioner, certifying dental practitioners to perform a dental procedure, and performance criteria for each of the group of certified dental practitioners.

Joao discloses dental and oral surgery training (para. 167) and a database containing statistical information such as treatment success rates and information on the treatment providers (para. 161 of Joao).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Joao within DeBruin-Ashton. The motivation for doing so would have been to train a variety of healthcare professionals, specifically dental practitioners (para. 167 of Joao) and to provide important information about healthcare-related professionals (para. 29 of Joao).

(B) Referring to claim 16, DeBruin-Ashton does not disclose wherein the performance criteria include data relating to successful patient outcomes.

Joao discloses wherein the performance criteria include data relating to successful patient outcomes (para. 161 of Joao; the Examiner interprets "treatment success rates" to be a form of "successful patient outcomes").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Joao within DeBruin-Ashton. The motivation for doing so would have been to provide important information about healthcare-related professionals (para. 29 of Joao).

(C) Referring to claim 17, DeBruin-Ashton discloses wherein informing comprises soliciting patients (col. 4, lines 31-47 of DeBruin-Ashton).

(D) Referring to claim 18, DeBruin-Ashton discloses wherein soliciting comprises advertising in print and/or electronic media (col. 4, lines 31-47 of DeBruin-Ashton).

(E) Referring to claim 19, DeBruin-Ashton does not disclose wherein certifying the dental practitioners comprises training the dental practitioners.

Joao discloses dental training (para. 167 of Joao).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Joao within DeBruin-Ashton. The motivation for doing so would have been to allow practitioners to remain current with procedures in their field (para. 8 of Joao).

(F) Referring to claim 21, DeBruin-Ashton does not disclose wherein certifying comprises requiring that the dental practitioners have performed at least one procedure.

Joao discloses wherein certifying comprises requiring that the dental practitioners have performed at least one procedure (para. 318 of Joao).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Joao within DeBruin-Ashton. The motivation for doing so would have been to evaluate the practitioner's performance and aptitude (para. 318 of Joao).

(G) Referring to claim 22, DeBruin-Ashton discloses removing practitioners from the certified group (col. 2, lines 42-44 of DeBruin-Ashton).

DeBruin-Ashton does not specifically disclose that the practitioners are dental practitioners.

Joao discloses dental practitioners (para. 131, lines 1-7 of Joao).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Joao within DeBruin-Ashton. The motivation for doing so would have been to provide a system that could be used by a variety of practitioners in the healthcare field (para. 131 of Joao).

(H) Referring to claim 29, DeBruin-Ashton discloses wherein identifying individual patients comprises collecting names and contact information from individual patients who contact a coordinator (col. 5, lines 58-67 of DeBruin-Ashton; the Examiner interprets "healthcare provider service" to be a form of "coordinator").

(I) Referring to claim 30, DeBruin-Ashton discloses wherein at least some of the individual patients contact a referral center who produces the referral list in response to solicitations from the coordinator (col. 4, lines 48-67 of DeBruin-Ashton).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Joao (US 2002/0032583 A1) as applied to claim 14 above, and further in view of Tawil (5,225,976).

(A) Referring to claim 15, DeBruin-Ashton and Joao do not disclose wherein the performance criteria include the number of dental procedures performed over a preselected time period.

Tawil discloses wherein the performance criteria include the number of dental procedures performed over a preselected time period (col. 3, lines 11-13 and col. 2, lines 66-67 of Tawil).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Tawil within DeBruin-Ashton and Joao. The motivation for doing so would have been to assist the patient's decision making process by providing information on the practitioners (col. 4, lines 57-59 of Tawil).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Joao (US 2002/0032583 A1) as applied to claim 14 above, and further in view of Falchuk et al. (US 2002/0152096 A1).

(A) Referring to claim 20, DeBruin-Ashton and Joao do not disclose wherein certifying the dental practitioners comprises testing the dental practitioners.

Falchuk discloses an examination (para. 30 of Falchuk).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Falchuk within DeBruin-Ashton and Joao. The motivation for doing so would have been to test the knowledge gained (para. 30 of Falchuk).

Claims 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Joao (US 2002/0032583 A1), and in view of Tawil (5,225,976), as applied to claims 14-15 above, and further in view of Kurzius et al. (US 6,385,620 B1).

(A) Referring to claim 23, DeBruin-Ashton and Joao do not disclose wherein the dental practitioners are placed into tiers based on the number of procedures performed and wherein the tiers are arranged in order on the list.

Tawil discloses tracking the number of times the procedure has been performed (col. 3, lines 3-21 of Tawil).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Tawil within DeBruin-Ashton and Joao. The motivation for doing so would have been to include background information on providers available for review by the patient to assist the patient's decision making process (col. 4, lines 57-59 of Tawil).

Kurzius discloses placing candidates into tiers based on experience and proficiency level and wherein the tiers are arranged in order (col. 17, lines 48-52 and col. 15, lines 23-29 of Kurzius; the Examiner interprets "ranking" to be a form of "arranged in order").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Kurzius within DeBruin-Ashton, Joao, and Tawil. The motivation for doing so would have been to have a ranking system that would save patients time associated with the review of practitioner profiles (col. 15, lines 45-50 of Kurzius).

(B) Referring to claim 24, DeBruin-Ashton discloses a random selection process (col. 8, lines 36-42 of DeBruin-Ashton).

(C) Referring to claim 25, DeBruin-Ashton, Joao, and Tawil do not disclose wherein the dental practitioners are assigned to at least three tiers.

Kurzius discloses wherein candidates are assigned to at least three tiers (col. 17, lines 48-52 of Kurzius; the Examiner interprets "beginner, intermediate, full-understanding, or expert" to be a form of "tiers").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Kurzius within DeBruin-Ashton, Joao, and Tawil. The motivation for doing so would have been to sort the practitioners by proficiency level (col. 17, lines 48-52 of Kurzius).

(D) Referring to claims 26 and 27, DeBruin-Ashton and Joao do not disclose wherein each tier is defined by a threshold number of procedures performed over a selected period of time and wherein each tier is defined by an aggregate number of procedures performed.

Tawil discloses tracking the number of times the practitioner has performed the procedure within a given amount of time (col. 3, lines 11-13 of Tawil).

Kurzius discloses wherein candidates are assigned to at least three tiers (col. 17, lines 48-52 of Kurzius; the Examiner interprets "beginner, intermediate, full-understanding, or expert" to be a form of "tiers").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Tawil and Kurzius within DeBruin-Ashton and Joao. The motivation for doing so would have been to provide information for review by

the patient to assist the patient's decision-making process (col. 4, lines 57-59 of Tawil) and to sort the practitioners by proficiency level (col. 17, lines 48-52 of Kurzius).

(E) Referring to claim 28, DeBruin-Ashton and Joao do not disclose wherein the dental practitioners are assigned to an initial tier when they become certified, to an intermediate tier when they treat a first threshold number of patients over a preselected time period, and to a higher tier when they treat a second threshold number of patients over the preselected time period.

Tawil discloses tracking the number of times the practitioner has performed the procedure within a given amount of time (col. 3, lines 11-13 of Tawil).

Kurzius discloses placing candidates into tiers based on experience and proficiency level (col. 17, lines 48-52 of Kurzius).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Tawil and Kurzius within DeBruin-Ashton and Joao. The motivation for doing so would have been to provide information for review by the patient to assist the patient's decision making process (col. 4, lines 57-59 of Tawil) and to sort the practitioners by proficiency level (col. 17, lines 48-52 of Kurzius).

Claims 46-49, 51-52, 55-56, and 58 rejected under 35 U.S.C. 103(a) as being unpatentable over Tawil (5,225,976) in view of Falchuk et al. (US 2002/0152096 A1).

(A) Referring to claim 46, Tawil discloses a method for maintaining a referral directory, said method comprising (col. 3, lines 3-18 of Tawil; the Examiner interprets "database" to be a form of "directory" and "updated" to be a form of "maintaining"):

tracking a number of times each certified practitioner performs the procedure (col. 3, lines 11-18 of Tawil; the Examiner interprets "updated" to be a form of "tracking"); and

maintaining a patient referral directory in an electronic database having information comprising the number of times each certified practitioner has performed the procedure, wherein certified practitioners selected from the electronic database are prioritized on a list based on the number of times each certified practitioner has performed the procedure (col. 3, lines 3-21 of Tawil; the Examiner interprets "sorted" to be a form of "prioritized").

Tawil does not disclose certifying practitioners to perform a medical procedure.

Falchuk discloses certifying practitioners to perform a medical procedure (para. 21 and para. 30 of Falchuk).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Falchuk within Tawil. The motivation for doing so would have been to educate medical professionals for effective delivery of health care services (para. 8, lines 6-9 of Falchuk).

(B) Referring to claims 47-49, Tawil does not disclose wherein certifying the practitioners comprises training practitioners, wherein certifying the practitioners comprises testing the practitioners, and wherein certifying comprises requiring that the practitioners have performed at least one procedure.

Falchuk discloses wherein certifying the practitioners comprises training practitioners (para. 21 of Falchuk), wherein certifying the practitioners comprises testing

the practitioners (para. 30 of Falchuk), and wherein certifying comprises requiring that the practitioners have performed at least one procedure (para. 30, lines 17-21 of Falchuk; the Examiner interprets "credits accumulated" to be a form of "performed at least one procedure").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Falchuk within Tawil. The motivation for doing so would have been to ensure standards and the effective delivery of health care services (para. 8, lines 6-9 of Falchuk).

(C) Referring to claim 51, Tawil discloses wherein tracking comprises determining the number of times a practitioner acquires a kit to perform the procedure on a patient (col. 3, lines 11-18 and 42-47 of Tawil; the Examiner interprets "determines the medical services and pharmaceutical prescriptions which are needed" to be a form of "acquires a kit").

(D) Referring to claim 52, Tawil discloses dividing the directory based on geographic location (col. 2, lines 46-47 and 64-65 of Tawil).

(E) Referring to claims 55 and 56, Tawil discloses wherein the number of times the procedure is performed is measured periodically over a fixed time interval and the directory periodically updated and wherein the practitioners are not ordered within a tier (col. 3, lines 3-21 of Tawil).

(F) Referring to claim 58, Tawil discloses wherein the directory is maintained in an electronic database (see abstract of Tawil).

Claims 50 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tawil (5,225,976) in view of Falchuk et al. (US 2002/0152096 A1) as applied to claims 46 and 58 above, and further in view of DeBruin-Ashton (6,014,629).

(A) Referring to claim 50, Tawil and Falchuk do not disclose removing practitioners from the certified group.

DeBruin-Ashton discloses removing practitioners from the certified group. (col. 2, lines 42-44 of DeBruin-Ashton; the Examiner interprets "updated...to reflect...the physicians that left the service" to be a form of "removing practitioners").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of DeBruin-Ashton within Tawil and Falchuk. The motivation for doing so would have been to have a routinely updated directory with the current list of practitioners active in the plan (col. 2, lines 57-59 of DeBruin-Ashton).

(B) Referring to claim 59, Tawil discloses generating a referral list for an individual patient from the patient referral directory, wherein the listed is generated automatically from the electronic database based on the patient's geographic location (see abstract and col. 2, lines 64-65 of Tawil).

Tawil and Falchuk do not disclose wherein practitioners with a higher priority have an increased likelihood of appearing on any referral list.

DeBruin-Ashton discloses wherein practitioners with a higher priority have an increased likelihood of appearing on any referral list (col. 3, lines 49-63 and col. 5, line 58 – col. 6, line 23 of DeBruin-Ashton; the Examiner interprets "specialties" to be a form

of "higher priority" and "intelligently extracted" to be a form of "increased likelihood of appearing").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of DeBruin-Ashton within Tawil and Falchuk. The motivation for doing so would have been for practitioners corresponding to customer's needs to show up first on the list (col. 3, lines 49-63 of DeBruin-Ashton).

Claims 53-54 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tawil (5,225,976) in view of Falchuk et al. (US 2002/0152096 A1) as applied to claims 46 and 52 above, and further in view of Kurzius et al. (6,385,620 B1).
(A) Referring to claims 53-54, Tawil and Falchuk do not disclose wherein the list is divided into at least two tiers with practitioners who have performed more than a first threshold number of procedures being in a higher tier and wherein the list is divided into at least three tiers with practitioners who have performed more than a first threshold number of procedures being in a higher tier, those who have performed more than a second threshold number but less than the first being in a lower tier, and those who have performed less than the second threshold number being in a still lower tier.

Kurzius discloses placing candidates into tiers based on experience and proficiency level (col. 17, lines 48-52 of Kurzius).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Kurzius within Tawil and Falchuk. The

motivation for doing so would have been to sort the practitioners by proficiency level (col. 17, lines 48-52 of Kurzius).

(B) Referring to claim 57, Tawil discloses tracking the number of procedures performed (col. 3, lines 3-21 of Tawil). However, Tawil does not expressly disclose ranking the practitioners within each tier based on this data.

Kurzius discloses placing candidates into tiers based on experience and proficiency level (col. 17, lines 48-52 of Kurzius).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Kurzius within Tawil and Falchuk. The motivation for doing so would have been to sort the practitioners by proficiency level (col. 17, lines 48-52 of Kurzius).

(10) Response to Argument

In the Appeal Brief filed 3 January 2007, Appellant makes the following arguments:

A) The Examiner uses DeBruin-Ashton as a sort of general framework in reconstructing, with use of deficient secondary references and a large amount of hindsight, a pieced-together, hypothetical system that only vaguely resembles that of the present invention.

B) The DeBruin-Ashton reference does not teach a database comprising the number of procedures performed and, moreover, is silent with respect to listing physicians preferentially based on the number of times a particular procedure has been

performed. The Examiner alleges that DeBruin-Ashton's use of "other selection algorithms" is equivalent to placing practitioners preferentially on a list based on the number of performed procedures. Applicants point out that this is distinctly different from the current disclosure and, in fact, produces a result opposite that currently disclosed, which is to refer practitioners who have more experience and are likely more efficient in performing the medical procedure for which they have been certified. Nowhere does DeBruin-Ashton teach certifying practitioners or listing physicians preferentially based on the number of times a particular procedure has been performed, as required in the current claims.

C) Falchuk fails to teach certifying a group of practitioners to perform a medical procedure.

D) Tawil fails to disclose providing a list of certified practitioners, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list, as recited in claim 1. Even if information from the Tawil database were provided to a patient, Tawil does not teach providing a list of certified practitioners or a list of any practitioners where those practitioners are organized (e.g., listed) in the manner specified according to the claimed invention.

E) DeBruin-Ashton actually teaches away from the proposed combination. DeBruin-Ashton teaches representing physicians who have newly joined the health care plan in a higher proportion than physicians that have been with the health care service for an extended period of time, which produces a result opposite that currently disclosed.

F) Kurzius has nothing to do with referring patients to medical practitioners, certifying practitioners to perform a medical procedure, or information regarding the number of medical procedures performed by medical practitioners. Allowing an employment candidate to indicate, in completing a candidate proficiency form, proficiency level selected from a list of categories (e.g., beginner, intermediate, etc.) simply is not equivalent to placing medical practitioners into tiers based on the number of medical procedures performed, as alleged by the Examiner.

G) Joao does not teach certifying dental practitioners to perform a dental procedure, as alleged by the Examiner.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

Argument A:

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Arguments B & E:

In response to Appellant's second and fifth arguments, the Examiner respectfully submits that DeBruin-Ashton teaches at col. 12, lines 47-54 a selection algorithm where physicians are represented in a higher proportion based on length of time with the health care service provider. As such, if the system is capable of selecting physicians who have newly joined the health care service plan, it is certainly capable of selecting physicians that have been with the health care service provider for an extended period of time.

In response to Appellant's arguments against DeBruin-Ashton individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Argument C:

In response to Appellant's third argument, the Examiner gave each term the broadest reasonable interpretation in light of the Applicant's specification. The Examiner referred to the specification, but was unable to find any definition given with precision, clarity, and deliberateness to warrant the meanings currently argued by

Appellant. Moreover, words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the Appellant. Where an Appellant chooses to be his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with "reasonable clarity, deliberateness, and precision" in the disclosure to give one of ordinary skill in the art notice of the change. See *Teleflex Inc. v. Ficosa North America Corp.,* 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.,* 273 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP § 2111.01. Pursuant to 35 USC § 112, 2nd paragraph "[i]t is Appellant's burden to precisely define the invention, and not the [examiner's]." *In re Morris,* 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). Therefore, it would **not** be proper for the examiner to give words of the claim special meaning when no such special meaning has been defined by the Appellant in the written description. In addition, it is noted that where a definition set forth in the written description is merely exemplary (i.e., where Appellant uses the phrase "for example") the Examiner should not consider this a special definition.

In this case, Appellant argues that while CME credits may be important for a physician to maintain an active medical license, the awarding of CME credits by consultation of a primary care physician with a specialist physician, as taught by Falchuk, distinctly differs from the certifying of a group of practitioners to perform a medical procedure. The Examiner respectfully submits that the specification does not set out a special definition explicitly and with "reasonable clarity, deliberateness, and

precision" of "certifying." For example, Appellant recites that "certification of the practitioners may be as simple as registering those practitioners who have a desire to perform the procedure. More usually, however, the practitioners will undergo education and/or training prior to certification. Such training will typically be provided by the company, organization, or other institution which sponsors the procedure, typically in the form of formal training sessions (e.g., seminars), written materials, electronic teaching materials, and presentations by a sales force, and the like. In addition to traning, certification may require that the practitioners be tested, and in some instances it may be desirable to require that the practitioners perform at least one procedure, usually with a previously certified practitioner or trainer present" (p. 2, lines 19-27 of Specification). However, this is not a special definition that has been set out with reasonable clarity, deliberateness, and precision. Instead the definition includes language such as "may" and "may be" which is merely exemplary. For these reasons, Appellant's claims were given their broadest reasonable interpretation consistent with the specification, and the Examiner has applied prior art accordingly.

Argument D:

In response to Appellant's arguments against Tawil individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Argument F:

In response to Appellant's argument that Kurzius is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Kurzius and the Applicant's invention are directed to assigning tiers to people, to perform a job, based on experience level.

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation of providing a ranking system based on qualifications to save time came directly from the reference.

Argument G:

In response to Appellant's seventh argument, the Examiner respectfully submits that the term "certifying" was given the broadest reasonable interpretation in light of the Applicant's specification (note the response to Argument C above). As such, the

broadest reasonable interpretation of the term "certifying" would include the dental training disclosed in Joao (para. 167 of Joao).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Lena Najarian
April 5, 2007

Conferees:

C. Luke Gilligan
Primary Examiner
Tech Center 3600

Vincent Millin
Appeals Conference Specialist
Tech Center 3600

C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

MICHAEL T. ROSATO
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, EIGHTH FLOOR
SAN FRANCISCO, CALIFORNIA 94111-3834